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09/206,329	12/08/98	ZHANG	G	970663 ^{RU} TRI
APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.

QM12/0302

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EVANISKO, G
EXAMINER

3762

ART UNIT

PAPER NUMBER

03/02/03

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/206329

Applicant(s)

Examiner

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 1/22/11
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-36 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-36 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 19-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 19, "coupling capacitors having a combined reduced capacitance" is vague and not supported by structure. The capacitors have not been set forth to be coupled or combined together to operate in the system. The claim has only set forth that there are "coupling capacitors" and has not provided any structure to have them "combined" to reduce the capacitance. It is suggested to use something similar to "coupling capacitors coupled together to produce a capacitance lower than the capacitance of each capacitor alone that together attenuate..."

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-4, 6, 11, 15, 19-22, 24, 29, and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Haefner et al (5690683). Haefner meets the limitations of the term "reduced capacitance".

6. Claims 1, 2, 16-20, and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zhu et al, 5843136 (or Zhu et al., 6044296).

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Zhu (or Zhu) discloses the claimed invention except for the sensing system having multiple independent blanking switches corresponding to independent electrodes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cardiac sensing system as taught by Zhu (or Zhu), with the multiple independent blanking switches corresponding to independent electrodes since it was known in the art that cardiac sensing systems include multiple independent blanking switches corresponding to independent electrodes to allow the system to selectively sense and/or blank signals from different electrodes in the heart.

7. Claims 3-15 and 21-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Zhu et al.

Zhu et al discloses the claimed invention except for the unipolar or bipolar sensing between atrial electrodes, ventricular electrodes, and case/can electrodes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have unipolar or bipolar sensing between atrial electrodes, ventricular electrodes, and case/can electrodes since it was known in the art that unipolar or bipolar sensing between atrial electrodes, ventricular electrodes, and case/can electrodes is used in pacers to sense heart activity and the particular configuration is chosen depending on implantation and sensing of particular heart conditions.

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Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5843136 or over claims 1-9 over U.S. Patent No. 6044296. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a unipolar or bipolar sensing system in the pacing system to sense, by unipolar or bipolar sensing, evoked responses from the heart using a combination of atrial electrodes, ventricular electrodes or can/case electrodes with multiple independent blanking switches corresponding to independent electrodes to provide a sensing system that can sense evoked responses in either heart chamber and that can selectively switch to either heart chamber.

Response to Arguments

10. Applicant's remarks filed 1/22/01 have been fully considered but they are not persuasive.

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The examiner has withdrawn the 112 second paragraph rejections of "reduced capacitance" in view of the arguments presented. In light of the arguments and specification, the examiner will consider a "reduced capacitance" as anything below 40 uF, since 40 uF is the top typical coupling capacitance in a pacemaker.

The arguments that Haefner et al does not meet "reduced capacitance" and that the attenuation circuit is not connected to the pacing circuit is not persuasive. First, Haefner's capacitance is below 40 uF and therefore is considered a "reduced capacitance". Second, the claims do not state that the pacing circuit is connected "directly to" or "through" the attenuation means, only that the pacing circuit is "electrically coupled" to the attenuation means. As seen in Haefner, in figures 1 and 2, the pulse circuit is "electrically coupled" to the afterpotential circuit, either through a wire or resistor or through the input-output terminals.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Evanisko whose telephone number is (703) 308-2612.

GRE

February 27, 2001

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GEORGE R. EVANISKO
PRIMARY EXAMINER

2/27/01